

**Remarks:**

This Amendment and the accompanying Request for Continued Examination are being filed responsive to the November 2, 2005 final Office action that was issued in connection with the above-identified patent application.

Prior to entry of this Amendment, claims 1-20 remained pending in the application. The Examiner rejects claims 13-14 under 35 U.S.C. § 102(b) as being anticipated by Maekawa et al.; rejects claims 1-12, 19, and 20 under 35 U.S.C. § 103(a) as being unpatentable over Hamilton et al. in view of applicant's submitted prior art in the specification; and rejects claims 15-18 under 35 U.S.C. § 103(a) as being unpatentable over Maekawa et al. in view of Hamilton et al.

By this Amendment, applicant has amended claims 1, 13, and 19, and canceled claims 8 and 17. In order to ensure consideration of the above amendments and the following remarks, applicant hereby submits a Request for Continued Examination under 37 C.F.R. § 1.114. Applicant respectfully requests reconsideration of the rejected claims.

***Rejections under 35 U.S.C. § 102(b)***

Claims 13-14 are rejected under 35 U.S.C. § 102(b) as being anticipated by Maekawa et al. (U.S. Patent No. 5,386,271). The Examiner suggests that Maekawa et al. discloses a processor configured to "collect a present description of one or more symptoms of a present printer system malfunction, to compare the present description to the database relationships, to identify a most appropriate malfunction that would produce the symptoms described in the present description, and to report the most appropriate malfunction," as recited in claim 13. Applicant respectfully disagrees. Nevertheless, but in the interest of furthering the prosecution of the

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application, applicant has amended claim 13 to recite that reporting the most appropriate malfunction includes electronically transmitting a report to a service center or service technician. Support for the amendment may be found in the specification at page 8, lines 8-21.

Elsewhere in the Office action, the Examiner suggests that Maekawa et al. discloses that "trouble data (i.e. error report) may be transferred to a center" and that the 'center' can be read on a service facility. Applicant again disagrees.

The system of Maekawa et al. includes a user side and a center side. The user side includes a copying machine 4, a data terminal 1, a modem 52, and a telephone machine 53. The center side includes a modem 72, a telephone machine 73, and a computer 90 that includes a CPU 91, a display 92, a keyboard 93, and a printer 94 (see col. 3, lines 36-60). The center receives data from data terminal 1, and CPU 91 then performs a diagnosis based upon the received data (see col. 5, line 64 to col. 6, line 12).

Therefore, Maekawa et al. cannot disclose reporting the most appropriate malfunction to a service center or service technician, because Maekawa discloses only transmission of data to CPU 91. The data is analyzed using CPU 91 only after transmission of the data. As CPU 91 is responsible for performing the diagnostic process, the data transmitted to CPU 91 cannot itself include a report identifying the most appropriate malfunction, (see Figs. 19, 20, 24 to 26).

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In order to anticipate a claim, the cited reference must disclose each and every element of the invention as claimed. Maekawa et al. fails to disclose each and every element of claim 13, as amended, and therefore, that claim 13 is allowable over Maekawa et al. As claim 14 depends from claim 13, applicant suggests that claim 14 is similarly allowable over Maekawa et al.

In view of the foregoing, applicant respectfully requests withdrawal of the rejection of claims 13 and 14 under 35 U.S.C. § 102.

***Rejections under 35 U.S.C. § 103(a)***

Claims 1-12, 19, and 20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Hamilton et al. (U.S. Patent no. 5,200,958) in view of the applicant's submitted prior art in the specification. Applicant respectfully disagrees. However, in the interest of furthering the prosecution of the application, applicant has amended claim 1 to include the subject matter of dependent claim 8.

Claim 1, as amended, recites a computer-implemented method for diagnosing a malfunction in a printer system, where the method includes communicating a present description of one or more symptoms of the printer system malfunction to a processor, correlating the one or more symptoms with known printer system malfunctions, where correlating the one or more symptoms includes comparing the present description of the one or more symptoms to a database relating symptoms to known printer system malfunctions, identifying a most appropriate malfunction that would produce the described symptoms, and reporting the most appropriate malfunction where reporting includes electronically transmitting a report.

As discussed previously, Hamilton et al. fails to disclose comparing a present description of symptoms to a database relating symptoms to known printer malfunctions, and fails to disclose any use of a database relating symptoms to known printer system malfunctions. As indicated at col. 2, line 29 to col. 3, line 8, the system of Hamilton et al. records a log of system faults, provides a log of faults that can be used online, provides an online diagnostic for verifying and/or isolating system faults, and conveys fault information to the operator. However, the system of Hamilton et al. fails to disclose identifying a most appropriate malfunction that would produce a set of one or more symptoms. Hamilton et al. only teaches providing diagnosed faults to an operator.

In rejecting claim 8, the Examiner has suggested that Hamilton et al. discloses in col. 8, lines 22-28 that a software client provides a means for relaying information, and that this corresponds to the step of electronically transmitting the report. Applicant respectfully disagrees.

As disclosed at col. 8, line 3-30, Hamilton et al. makes quite clear that the software client "acts as an intermediary between the operator and the internal diagnostic services" and that "online and offline diagnostic services consist of a specific, established sequence of steps for identifying and evaluating each specific type of faults which can occur". The software client of Hamilton et al. is concerned with the identification of specific faults, not with the correlation of symptoms with known malfunctions. As Hamilton et al. fails to generate any report that identifies a most appropriate malfunction, Hamilton et al. necessarily fails to disclose the electronic transmission of such a report. Further, the disclosure of Hamilton et al.

makes very clear that the software client is not used for transmitting such a report, nor is it even disclosed as useful for the transmission of such a report.

In order to establish *prima facie* obviousness, the cited references must disclose each and every element of the rejected claim. As Hamilton et al. fails to disclose each and every element of claim 1, as amended, Hamilton et al. fails to render claim 1 unpatentable. As claims 2-7 and 9-12 depend directly or indirectly from claim 1, applicant suggests these claims are similarly not rendered unpatentable by Hamilton et al. Applicant's specification (referenced only generally by the Examiner) adds nothing to Hamilton et al. which would render the aforementioned claims obvious.

With respect to claim 19, applicant has amended the claim to recite a computer implemented method of diagnosing a malfunction of a printer system using a processor, where the most likely malfunction is electronically reported to a service center or service technician.

As discussed above, Hamilton et al. fails to generate a report that identifies a most appropriate malfunction, and fails to disclose the electronic transmission of such a report. Also as discussed above, Maekawa et al. (although claims 1-12, 19 and 20 are rejected based only on Hamilton et al. in view of applicant's specification, the Examiner references Maekawa et al. in discussing the rejection of these claims) discloses only the transmission of fault data, and Maekawa et al. fails to disclose transmission of a report identifying a most appropriate malfunction. Therefore, Maekawa et al. cannot disclose reporting the most appropriate malfunction to a service center or service technician.

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Applicant respectfully suggests that Hamilton et al. and Maekawa et al., even in combination, fail to establish the *prima facie* obviousness of the subject matter of claim 19, as they fail to disclose each and every element of the claim.

Claims 15-18 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Maekawa et al. (U.S. Patent no. 5,386,271) in view of Hamilton et al. (U.S. Patent no. 5,200,958). Applicant has amended claim 13 (from which claims 15-18 depend) to recite that reporting the most appropriate malfunction includes electronically transmitting a report to a service center or service technician. As discussed above, Maekawa et. al fails to disclose transmitting a report electronically.

With respect to claim 17, now canceled, the Examiner has suggested that Maekawa et al. discloses that a report is displayed. Applicant suggests that Maekawa et al. discloses only displaying "a cause of trouble, measures to be taken and a possibility thereof operated by the diagnostic process" (at col. 12, lines 48-50). Applicant continues to disagree that the diagnostic process of Maekawa et al. corresponds to the recited reporting of a most appropriate malfunction, applicant also contends that a display of the diagnostic results to the user does not correspond to "electronically transmitting a report to a service center or service technician."

The Examiner has suggested that "one skilled in the art would know that such a report can be sent to a user if needed," and that "the motivation would be to allow a user to see possible solutions to an error that has occurred". Elsewhere in the Official action the Examiner identifies motivation to combine and/or modify the references such as

- "Although it is not explicitly stated to compare the error log, *it would make sense to one of ordinary skill in the art to do so* since error logs provide detailed explanations of errors that have occurred." (with respect to claim 16)
- "one skilled in the art *would understand* that one can simply note information from this counter if a part replacement would be a likely solution to a malfunction" (with respect to claims 10 and 18)

Applicant suggests the Examiner is following an improper standard for establishing *prima facie* obviousness under 35 U.S.C. § 103. As set out at MPEP § 2143.01, the prior art must suggest the desirability of the invention, that is, the motivation to formulate the invention cannot be found in applicant's specification, which is then used as a filter through which to view the prior art. The mere fact that references *can be* combined or modified does not render the resultant combination obvious unless the prior art *also* suggests the desirability of the combination. Without some objective reason in the references to combine the teachings of the references, even a statement that modifications of the prior art to meet the claimed invention would have been "well within the ordinary skill of the art at the time the claimed invention was made" is not sufficient to establish a *prima facie* case of obviousness.

In view of the above amendments and remarks, applicant suggests that claims 1-12, and 15-20 are not rendered *prima facie* obvious by the cited references, and therefore respectfully request the withdrawal of the rejection of those claims under 35 U.S.C. § 103.

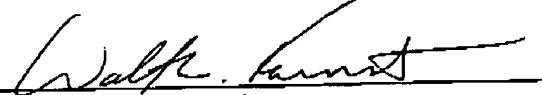
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**Conclusion**

Applicant believes that this application is now in condition for allowance, in view of the above amendments and remarks. Accordingly, applicant respectfully requests that the Examiner issue a Notice of Allowability covering the pending claims. If the Examiner has any questions, or if a telephone interview would in any way advance prosecution of the application, please contact the undersigned attorney of record.

Respectfully submitted,

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**CERTIFICATE OF FACSIMILE TRANSMISSION**

I hereby certify that this correspondence is being facsimile transmitted to Examiner Y. Qin, Group Art Unit 2622, Assistant Commissioner for Patents, at facsimile number (571) 273-8300 on February 2, 2006.



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